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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
AKINTOLA, OLABODE	
ART UNIT	PAPER NUMBER
3691	

NOTIFICATION DATE	DELIVERY MODE
06/05/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM

Office Action Summary	Application No.	Applicant(s)	
	09/706,849	FISHER ET AL.	
	Examiner	Art Unit	
	OLABODE AKINTOLA	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-22,24-30,32-39,41-48 and 50-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-22,24-30,32-39,41-48 and 50-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/24/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/06/2009 has been entered.

Status of Claims

Claims 18-22, 24-30, 32-39, 41-48 and 50-52 are pending. The rejections cited are as stated below:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-22, 24-30, 32-39, 41-48 and 50-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Here, the state of the law with respect to statutory subject matter eligibility under §101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard to process claims. As presently understood, based on Supreme Court precedent and recent Federal Circuit decisions, [see Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook,

437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)] a §101 statutory process must (1) be tied to another statutory class (e.g. such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met, a method is not a patent eligible process under §101 and should be rejected as being directed to non-statutory subject matter.

For example, a method claim that recites purely mental steps (e.g. can be performed by mental process or human intelligence alone) would not qualify as a statutory process. To qualify as a §101 statutory process, the claim should (1) positively recite another statutory class (e.g. thing or product) to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps) or (2) positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

As per Claim 26, Examiner asserts that Applicant does not adequately tie his/her steps to another statutory class to qualify as a §101 statutory process. In order to overcome this rejection, the ***critical step(s)*** of claim limitations (in the body of the claims) must be tied to an apparatus, for example a processor.

Claims 27-30 and 32-34 are similar rejected under the same rationale.

As per claim 18, Examiner broadly interprets "posting means for", "bid receiving means for", "bid validation means for", and "bid categorizing means for" as software per se. It is not clear whether the software is in executable form and therefore there is no practical application.

Examiner notes that the claims recites "storing the bid in a bid database", however, this is a process step. Amending the claims to recite a "bid database storing the bid" will overcome this rejection.

As per claim 35, the preamble recites " a computer readable medium containing instructions for controlling a computer ..". This is considered software per se since the instructions are not in executable form. Examiner suggests amending the claims to read "a computer readable medium containing instructions which when executed by a computer conduct an auction comprising…"

Claims 19-22 and 24-25 are similar rejected under the same rationale.

As per claim 44, Examiner broadly interprets "merchandise posting mechanism", "bid receiver", "bid validator", and "auction manager" as software per se. It is not clear whether the software is in executable form and therefore there is no practical application.

Claims 45-48 and 50-52 are similar rejected under the same rationale.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-22, 24-25, 44-48 and 50-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 18, Claim elements "posting means for", "bid receiving means for", "bid validation means for", and "bid categorizing means for" are means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Examiner broadly interprets these "means for" as software per se. Software per se is insufficient disclosure of the corresponding structure for performing the claimed function.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or

associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claims 19-22, 24-25 are similar rejected under the same rationale.

As per claims 18 and 44, it is not clear what the structures of the "system" claims are because they comprise software. Amending the claim to recite from "storing the bid in a bid database" to "a bid database storing the bid" as suggested in the §101 rejection above will not overcome this rejection because the software and database do not constitute a proper structure for a system claim.

Claims 19-22, 24-25, 45-48 and 50-52 are similar rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 18-19, 22, 24, 26-27, 30, 33, 35-36, 39, 41-42, 44-45, 48, 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston (USPN 5845265) ("Woolston") in view of Fraser et al (US 5329589) ("Fraser") and further in view of Anderson (US 4319336) ("Anderson")

Re claims 18, 26, 35 and 44: Woolston teaches computer system for conducting an auction through a computer network, the system comprising: a posting means for posting to a computerized merchandise catalog information that is accessible through the computer network, the information describing each lot in a plurality of lots available for auction, each lot including at least one item (col. 3, lines 8-67, col. 4, lines 10-27, col. 5, lines 48-55), the posting means available to add a lot for auction during an auction of another lot, wherein the information related to items in each lot is substantially continuously updated in the merchandise catalog as items in each lot are made available for auction (col. 7, lines 16-30); a bid receiving means for receiving a bid for at least a portion of a lot of the plurality of lots (col. 6, lines 21-29); a bid validation means for examining the bid (col. 6, lines 37-44); and a bid categorizing means for determining whether the bid is successful or unsuccessful (col. 6, lines 30-33, col. 10, lines 33-63), and storing the bid in a bid database (col. 6, lines 21-44).

Woolston does not explicitly teach a bid validation means for examining and validating a characteristic of the bid during and prior to a close of the auction, the characteristic of the bid being a form of bid information, and the validating of the characteristic includes ensuring that the bid information accords with a specific form of the bid information that is defined by a bid format.

Fraser teaches a bid validation means for examining and validating a characteristic of the bid during and prior to a close of the auction, the characteristic of the bid being a form of bid information (col. 14, lines 16-28). It would have been obvious to one of ordinary skill in the art

at the time of the invention to modify Woolston to valid a characteristic of bid as taught by Fraser. One would have been motivated to do so in order to ensure that the bid information is valid.

Anderson teaches the concept of validating the characteristic of data inputted by a customer (*characteristic of bid*) by checking to insure that the inputted data falls within a minimum and maximum values established for the key (*specific form of the bid information defined by a bid format*). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston and Fraser combination to include this feature as taught by Anderson. One would have been motivated to do so in order to insure that the bid information values falls within acceptable range or format established for the characteristic, thereby preserving the integrity of process/system.

Re claims 19, 27, 36 and 45: Woolston teaches an auction selection means for associating each lot of the plurality of lots with an auction format selected from a plurality of auction formats (col. 5, line 50)

Re claims 22, 30, 39 and 48: Woolston teaches wherein the posting means is adapted to receive a message posted through the computer network corresponding to a lot and to post the message in association with the descriptive information for that lot (Figure 13).

Re claims 24, 32, 33, 41, 42, 50 and 51: Woolston teaches wherein the bid receiving means is for receiving bids on at least two lots that are simultaneously open for auction, the at least two lots having different associated auction formats, and wherein the bid categorizing the means is for automatically categorizing the received bids as successful or unsuccessful in accordance with the associated auction format for each lot (col. 11, lines 6-10).

Claims 20, 28, 37 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Fraser in view of Anderson in view of Huberman (US 5826244) ("Huberman").

Re claims 20, 28, 37 and 46: Woolston/Fraser/Anderson combination does not explicitly teach an auction format of the plurality of auction formats comprises one selected from the group comprising: Dutch auction, standard auction, progressive auction, and buy or bid auction. Huberman teaches an auction format of the plurality of auction formats comprises one selected from the group comprising: Dutch auction, standard auction, progressive auction, and buy or bid auction (col. 10, lines 48-61).). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston/Fraser/Anderson combination to include this feature as taught by Huberman. One would have been motivated to do so in order to allow for flexibility taking into account customer preferences and the nature and characteristics of the item being auctioned.

Claims 21, 29, 38 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Fraser in view of Anderson in view of Brown (US 5794219) ("Brown").

Re claims 21, 29, 38 and 47: Woolston/Fraser/Anderson combination does not explicitly teach wherein bid-receiving means receives the bid from a bid form. Brown teaches wherein bid-receiving means receives the bid from a bid form (Figures 5, 6 and 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston/Fraser/Anderson combination to bid forms as taught by Brown. One would have been motivated to do so in order to provide a standard format for which bidder enter their bids.

Claims 25, 34, 43 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston in view of Fraser in view of Anderson in view of Mackinnon, D. J. ("Playing the Auction Game"; SU2 Edition, Toronto Star, Ont.: Oct. 4, 1987. pg E.1) ("Mackinnon").

Re claim 25, 34, 43 and 52: Woolston/Fraser/Anderson combination does not explicitly teach proxy bidding. Mackinnon teaches of proxy bidding (page 3 of 3, paragraph 26). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Woolston/Fraser/Anderson combination to include this feature as taught by Mackinnon. One would have been motivated to do so in order allow participant to set maximum bids without monitoring the auction.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olabode Akintola/
Examiner, Art Unit 3691